REMARKS

Claim Rejections Under 35 U.S.C. § 112

Claim 12 was rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 12 has been amended to overcome the rejection under 35 U.S.C. §112, second paragraph. Claim 13 has also been amended in order to maintain proper antecedence in view of the amendment of claim 12. Applicant thus respectfully requests reconsideration and withdrawal of the rejection under 35 U.S.C. § 112, second paragraph, and allowance of claim 12.

Claim Rejections Under 35 U.S.C. § 103

Claims 1-4, 8-12 and 15-19

Claims 1-4, 8-12 and 15-19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Garceran et al. (U.S. Patent No. 6,522,888 B1) in view of Olkkonen et al. (U.S. Patent No. 6,842,460 B1).

Applicant contends that Garceran et al. does not identify and prioritize wireless network devices as Applicant claims. In contrast, Garceran et al. is directed to a system for determining coverage in a wireless communications system using historical information gathered from wireless devices. *See,* Garceran et al., column 2, lines 7-34. Applicant has amended claims 1, 12 and 18 to more clearly define this differentiation.

Claim 1 is amended to recite, in part, "in response to identifying each of the detected wireless network devices that match the selection criteria, associating the at least one signal quality with its respective wireless network device for each wireless network device that matches the selection criteria." While Applicant acknowledges that Garceran et al. stores signal quality information for wireless devices, and stores additional information associated with that signal quality information, Applicant contends that Garceran et al. stores this information regardless of whether a wireless device matches some selection criteria. In fact, any sorting of the database in Garceran et al. occurs after storing the information. Applicant thus contends that Garceran et al. cannot store its database information in response to identifying a detected wireless network

device as matching a selection criteria. The secondary reference of Olkkonen et al. fails to cure this deficiency in Garceran et al. such that the references, taken alone or in combination, fail to teach or suggest at least this limitation of claim 1.

Claim 1 further recites, in part, "prioritizing the wireless network devices that match the selection criteria based on their associated at least one signal quality." The Office Action asserts that Olkkonen et al. teaches this limitation of claim 1. Office Action, page 2, last paragraph. Applicant respectfully traverses. Applicant contends that it would require a change in the principle of operation in Garceran et al. to be modified in this manner. *See* MPEP § 2143.01 (if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious). Because Garceran et al. is concerned with developing coverage information, it is irrelevant whether a devices matches some selection criteria as the system of Garceran et al. is communicating with, and collecting information from, each detected wireless device. As such, prioritization would be an unnecessary and wasted effort. Thus, Applicant contends that it is improper to combine these references in support of a rejection under 35 U.S.C. § 103(a).

Applicant further contends that Garceran et al. and Olkkonen et al. are non-analogous arts. Specifically, Garceran et al. is directed to determining coverage in a wireless communications system. *See, e.g.,* Garceran et al., Abstract. In contrast, Olkkonen et al. is directed to the creation of ad hoc networks. *See,* Olkkonen et al., Abstract. Applicant contends that determination of coverage in a wireless communications system is wholly unrelated to the function of creating ad hoc networks. Applicant further contends that a person having ordinary skill in the art would not reasonably have expected to solve any problem identified in Garceran et al. using the network creation teachings of Olkkonen et al. *Cf.* MPEP § 2141.01(a) (II) and (a)(V). As such, Applicant respectfully submits that the references cannot be properly combined in support of a rejection under 35 U.S.C. § 103(a), and the rejection is therefore improper.

Claim 12 is amended to recite, in part, "associating the signal quality with the wireless network device in response to determining that it is of the desired type and it has the desired status." As noted with respect to claim 1, even if combination of the references is proper, which Applicant denies, Applicant contends that the references, taken either alone or in combination,

fail to teach or suggest at least this limitation. Claim 12 further recites, in part, "generating a list of wireless network devices that are of the desired type and have the desired status." The Office Action asserts that Garceran et al. satisfies this limitation. Office Action, page 5, last paragraph. However, Applicant contends that the cited section of Garceran et al. only refers to the collection of information for a given wireless device and does not purport to teach or suggest the generation of a list of wireless network devices having a desired type and a desired status. The secondary reference of Olkkonen et al. is not cited to cure this deficiency in Garceran et al. and Applicant contends that it cannot do so. As such, Applicant contends that the references, taken either alone or in combination, further fail to teach or suggest at this limitation of claim 12.

Claim 18 is amended to recite, in part, "if a wireless network device matches the selection criteria, associating that wireless network device and its supplemental information with its at least one signal quality." As noted with respect to claim 1, even if combination of the references is proper, which Applicant denies, Applicant contends that the cited references, taken either alone or in combination, fail to teach or suggest at least this limitation.

In view of the foregoing, Applicant contends that independent claims 1, 12 and 18 are patentably distinct over the cited references, taken either alone or in combination. As claims 2-4 and 8-11 include all patentable limitations of claim 1, claims 15-17 include all patentable limitations of claim 12, and claim 19 includes all patentable limitations of claim 18, these claims are also believed to be allowable. Applicant thus respectfully requests reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a), and allowance of claims 1-4, 8-12 and 15-19.

Claim 7

Claim 7 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Shultz (U.S. Patent No. 5,603,087) in view of Terlep et al. (U.S. Patent No. 5,976,777). Applicant notes that the body of the rejection does not mention Shultz, but instead refers only to the combination of Garceran et al. and Olkkonen et al. with the addition of Terlep et al. Applicant thus presumes that the rejection does not rely on Shultz as stated in its opening paragraph and will respond to the body of the rejection. If the rejection is meant to be over Shultz in view of Terlep et al.,

Applicant contends that it has not been apprised of the substance of the rejection and requests that a new non-final rejection be issued stating the basis for the rejection over Shultz.

Applicant contends that it has shown amended claim 1 to be patentably distinct over the references of Garceran et al. and Olkkonen et al. whether taken alone or in combination. The tertiary reference of Terlep et al. fails to cure the deficiencies of the primary and secondary references with respect to claim 1. As claim 7 includes all patentable limitations of claim 1, Applicant contends that the references of Garceran et al., Olkkonen et al. and Terlep et al., taken either alone or in combination, necessarily fail to teach or suggest each and every of this claim as well. Applicant thus respectfully requests reconsideration and withdrawal of the rejection under 35 U.S.C. § 103(a), and allowance of claim 7.

Claims 13-14 and 20

Claims 13-14 and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Garceran et al. (U.S. Patent No. 6,522,888 B1) in view of Olkkonen et al. (U.S. Patent No. 6,842,460 B1) and further in view of Dupray (U.S. Published Application No. 2004/0266457 A1).

Applicant contends that it has shown amended claims 12 and 18 to be patentably distinct over the references of Garceran et al. and Olkkonen et al. whether taken alone or in combination. The tertiary reference of Dupray fails to cure the deficiencies of the primary and secondary references with respect to claim 12 or claim 18. As claims 13-14 include all patentable limitations of claim 12, and claim 20 includes all patentable limitations of claim 18, Applicant contends that the references of Garceran et al., Olkkonen et al. and Dupray, taken either alone or in combination, necessarily fail to teach or suggest each and every of these claims as well. Applicant thus respectfully requests reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a), and allowance of claims 13-14 and 20.

CONCLUSION

Claims 1, 12, 13 and 18 are amended herein. Claims 1-20 are currently pending.

In view of the above remarks, Applicant believes that all pending claims are in condition for allowance and respectfully requests a Notice of Allowance be issued in this case. Please charge any further fees deemed necessary or credit any overpayment to Deposit Account No. 08-2025.

Respectfully submitted,

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